

REMARKS

Claims 1-30 are pending. Claims 1-10 were examined and rejected. Claims 11-30 were withdrawn by the Examiner.

Claim 1 is amended for clarity. No new matter has been added.

In view of the above amendments and the following remarks, the Examiner is requested to allow claims 1-10.

Rejection of claims under 35 U.S.C. § 112, second paragraph

Claims 1-7 and 9-10 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential steps. The Applicants respectfully traverse this rejection.

As best understood by the Applicants, this rejection appears to be based on the idea that it is unclear how a compound capable of modulating Fcγ receptor signaling can be identified. Specifically, since claim 8 is not included in this rejection, the rejection appears to be based on the idea that there is no way for one of skill in the art to determine whether a candidate compound modulates Fcγ receptor-mediated signaling without comparing results to a control.

The MPEP states that 35 U.S.C. § 112, second paragraph, requires that claims particularly point and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant. This requirement is an objective one and is evaluated in the context of “whether the claim is definite - i.e., whether the scope of the claim is clear to a hypothetical person possessing the ordinary level of skill in the pertinent art.” (see MPEP § 2171). If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. § 112, second paragraph. (see MPEP § 2173.04). Further, the breadth of a claim is not to be equated with indefiniteness. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

The question in this case is therefore whether the metes and bounds of the claim are clear. The Applicants submit that the metes and bounds of the instant claims are quite clear to one of skill in the art and, as such, this rejection should be withdrawn.

The Applicants submit that the meaning of the term “determining” would be adequately understood and does not make the claim unclear. The term “determining” is a dictionary defined, well used word that does not have an ambiguous meaning. Further, the Applicants note that over 300,000 issued patents (i.e., approximately 4% of all issued patents) have the word “determining” recited in the claims (see Exhibit A), and in 9 of the first 10 of those patents the word “determining” is used as the first word in a step of the claim. Moreover, the Applicants note that over 2500 issued patents have the words “determining” and “assay” recited in the claims (see Exhibit B), and in 9 of the first 10 of those patents the word “determining” is used as the first word in a step of the claim. Thus, the Applicants believe that the word “determining” is not a word that introduces ambiguity into patent claims. Rather, the word “determining” is often used in patent claims because it has a defined meaning.

In the context of the claimed method, one of skill in the art would read “determining” as encompassing comparing results to control results. However, since the method can be performed in the absence of a control experiment and still work, the Applicants submit that the claims need not be further defined.

Finally, the Applicants note that the claimed method, including the determining step, may be practiced in a variety of different ways. However, as noted above, it is well established that the mere fact that a claim can be practiced in a variety of different ways cannot in itself render that claim indefinite. *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

The Applicants submit that this rejection has been adequately addressed. Withdrawal of this rejection is requested.

Rejection of claims under 35 U.S.C. § 102

Claims 1-10 were rejected under 35 U.S.C § 102(e) as anticipated by Wabl (WO03/074652). The Applicants respectfully traverse this rejection.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Additionally, the identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1566 (Fed. Cir. 1990).

The claims of this case require an “IgE primed mast cell that comprises an activated Fcγ receptor” (reworded from an “IgE primed mast cell.... in the presence of Fcγ receptor signaling activation”). The Fcγ (i.e., Fc-gamma) receptor is different to the Fcε (i.e., Fc-epsilon) receptor. As is well known, the Fcγ receptor is activated by IgG, whereas the Fcε receptor is activated by IgE.

While Wabl discloses IgE primed mast cells and performing screening assay using IgE activated mast cells (which necessarily comprise an activated Fcε receptor, i.e., an activated Fc-*epsilon* receptor), Wabl does not disclose any screening assay that uses a “mast cell comprising an activated Fcγ receptor” (i.e., an activated Fc-*gamma* receptor), as required by the instant claims. Wabl makes no mention of activating the Fcγ receptor of a mast cell, or of any screening assay that employs mast cells that comprise an activated Fcγ receptor.

Thus, Wabl’s uses mast cells that are different to those recited in the rejected claims..

In the Office Action, the Examiner cites *Bristol-Myers* 58 USPQ2d 1508 (Fed. Cir. 2001) in support of the rejection. However, even in view of *Bristol-Myers*, the fact remains that the method claimed in the instant case uses mast cells that are different to those of Wabl. Thus, the claimed method is different to that of Wabl, and this rejection should be withdrawn.

Withdrawal of this rejection is requested.

The Applicants respectfully requests that a timely Notice of Allowance be issued in this case.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815, order number RIGL-047.

Respectfully submitted,
BOZICEVIC, FIELD & FRANCIS LLP

Date: December 5, 2007

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Enclosures: Exhibit A and Exhibit B

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EXHIBIT A

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[Refine Search](#) ACLM/determining

PAT. NO.	Title
1 RE39,931	T Method of controlling operation of animal training device
2 7,305,714	T Anti-theft device for computer apparatus and a method for protecting computer apparatus thereby
3 7,305,710	T Method for securely loading and executing software in a secure device that cannot retain software after a loss of power
4 7,305,709	T System, method, and computer program product for conveying a status of a plurality of security applications
5 7,305,708	T Methods and systems for intrusion detection
6 7,305,707	T Method for intrusion detection in a database system
7 7,305,706	T Establishing a virtual private network for a road warrior
8 7,305,704	T Management of trusted flow system
9 7,305,703	T Method and system for enforcing a communication security policy
10 7,305,702	T Systems and methods for distributed administration of public and private electronic markets
11 7,305,699	T Method and apparatus for generating carousels
12 7,305,693	T User interface for interactive television systems
13 7,305,692	T Scheduling the recording of television programs
14 7,305,686	T Optical disk player
15 7,305,681	T Method and apparatus for providing multi-client support in a sip-enabled terminal
16 7,305,675	T Processing tasks with failure recovery
17 7,305,674	T Method and apparatus to manage multi-computer supply

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EXHIBIT B

[Refine Search](#) ACLM/determining AND ACLM/assay

PAT. NO.	Title
1 7,303,923	T Biochemical and immunochemical assay device
2 7,300,778	T Human proteins responsible for NEDD8 activation and conjugation
3 7,300,768	T Enzymatic measurement of imatinib mesylate
4 7,300,767	T Aspartate carbamyltransferase as herbicidal target
5 7,300,761	T Methods and device for detecting prostate specific antigen (PSA)
6 7,300,749	T Molecules of the pyrin domain protein family and uses thereof
7 7,297,479	T DNA-based analog neural networks
8 7,295,316	T Fluorescent detector with automatic changing filters
9 7,294,479	T Compositions, kit and one-step method for monitoring compounds having anti-factor X.sub.a and/or anti factor II.sub.a activities
10 7,294,472	T Method for identifying modulators of G protein coupled receptor signaling
11 7,292,944	T Establishment of biological cut-off values for predicting resistance to therapy
12 7,291,504	T Assay involving detection and identification with encoded particles
13 7,291,480	T Device and method for detecting antibiotic-inactivating enzymes
14 7,285,393	T Assay for modulation of .gamma. secretase
15 7,282,345	T C-erbB-2 external domain: GP75
16 7,282,340	T Methods for identifying an analog that promotes nerve regeneration
17 7,282,335	T Detection of extracellular tumor-associated nucleic acid in blood plasma or serum using nucleic acid amplification assays
18 7,280,683	T Method, code, and system for assaying joint deformity
19 7,279,676	T Position sensitive radiation spectrometer